

### REMARKS

The Office Action mailed October 18, 2005 has been received and reviewed. Claims 21-40 are in the case. Claims 21-40 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 36-40 stand rejected under 35 U.S.C. § 102(b). Claims 21-35 stand rejected under 35 U.S.C. § 103(a).

For the reasons set forth below, claims 21-40 are believed to be in condition for immediate allowance. Favorable reconsideration of the application in view of the following remarks, is therefore respectfully requested.

#### Rejection of Claims 21-40 Under 35 U.S.C. §112

Claims 21-40 stand rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Office Action asserts that a spring loaded to urge at least one full revolution, as recited in claims 21-40, was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Accordingly, the Office Action asserts that a spring loaded to urge at least one full revolution constitutes new matter. Under scrutiny, Applicant finds this assertion contrary to fact.

Applicant's Figure 2 illustrates the take-up device 10 of Figure 1 "in a contracted height configuration and with the safety trigger engaged." (Specification page 7, lines 17, 18.) In Figure 3, Applicant illustrates the take-up device 10 of Figure 1 "in an expanded height configuration and with the safety trigger disengaged." (Specification page 7, lines 19, 20.) In Figure 4, Applicant illustrates the take-up device 10 of Figure 1 in "an exploded assembly view." (Specification page 7, line 21.) Applicant further discloses that the take-up device 10 of Figure 1 transitions between the "contracted

height configuration” and the “expanded height configuration” under the urging of a spring 50, which “provides a practical, self-energizing source to slide a sliding member 36 relative to a base member 42, thereby to extend the a take-up unit 10 in height.” (Specification page 13, lines 18-20.)

A casual review of Figures 2 and 3 reveals that, given the illustrated thread pitch, spring 50 must urge at least one revolution for the take-up device 10 to effect the illustrated change in height. For example, as illustrated and disclosed with respect to Figure 3, the take-up device has “a socket 48, which receives the trigger mechanism 40 when the unit is configured for installation height,” (*i.e.*, the height illustrated in Figure 2). (Specification page 12, lines 9, 10.) Given, the relative positions of the trigger 40 and the socket 48 as illustrated in Figure 3, and considering the relative positions of those components 40, 48 when they engage one another as illustrated in Figure 2, the spring 50 urges at least one revolution during the transition.

Thus, the Office Action’s assertion that a spring loaded to urge at least one full revolution constitutes new matter is contradicted by Applicant’s Specification as filed. Reconsideration is respectfully requested.

#### **Rejection of Claims 36-40 Under 35 U.S.C. §102(b)**

Claims 36-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by Erikson. In maintaining this rejection, the Office Action misapplies the legal standard for anticipation. For a prior art reference to anticipate, every element of the claimed invention must be identically disclosed in a single prior art reference. *Carella v. Starlight Archery & Pro Line*, 804 F.2d 135, 138 (Fed. Cir.

1986). Erikson does not disclose a spring positioned and loaded to urge at least one revolution, as recited. Accordingly, Erikson does not qualify as an anticipating reference.

As appreciated, due to geometric and material characteristics, all coil and torsion springs are not inherently capable of being loaded to urge at least one revolution. Nowhere does Erikson state that spring 26 is loaded to urge at least one revolution. Looking at Erikson's illustrations, it is not clear that spring 26 can, alone or otherwise, be loaded sufficiently to urge at least one revolution. Nowhere does Erikson state that spring 26 is capable, alone or otherwise, of being loaded to urge at least one revolution. Nowhere does Erikson state that spring 26 is contemplated or required to take-up more than the necessarily small gap produced by "nut wear," for which one revolution of spring loading would be extreme overkill.

Moreover, the structures illustrated by Erikson are not obviously capable of supporting a spring loaded to urge at least one revolution. In fact, as presented in a previous Response to Office Action filed in this case by Applicant on August 4, 2005, they appear to be structurally incapable of accommodating such a loading. Therefore, it is contrary to law to maintain that Erikson "identically discloses" Applicant's claimed invention.

While the Office Action has asserted anticipation by Erikson, it is noteworthy that Erikson cannot even support an obviousness rejection of Applicant's claimed invention. Erikson teaches against loading spring 26 more than is necessary to take up the gap produced by nut wear. As appreciated, nut wear is small when compared to the pitch of the threads between the retainer means 24 and spacer 28. Far less than one revolution of the spacer 28 with respect to the retainer means 24 will "take up the gap" left by "nut wear," which must be less than the thread thickness, and much much less than one

pitch distance. Loading the spring 26 sufficiently to urge at least one revolution as claimed by Applicant would increase the "force between nut halves," without providing any added benefit. As appreciated, this is contrary to the expressed objective of Erikson to minimize such forces. (See Erikson column 1, lines 30-40 and column 3, lines 35-41.)

**Rejection of Claims 21-24, 28-32, 34, and 35 Under 35 U.S.C. §103(a)**

Claims 21-24, 28-32, 34, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reh in view of Erikson.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See MPEP 2143.)

The combination of Reh and Erikson fails to meet this test for at least two independent bases. First, the combination fails to teach or suggest all of Applicant's claim limitations. Second, Reh teaches against incorporation of the threads taught by Erikson, destroying the requisite suggestion or motivation to combine reference teachings.

With respect to the first independent basis, the combination of Reh and Erikson fails to teach or suggest a coil spring "loaded in torsion to urge at least one revolution of the slide with respect to the base," as required by Applicant. Reh teaches a maximum relative rotation of "270 degrees." (Reh column 5, lines 45-48.) The addition of Erikson does not remedy this deficiency of teachings or

suggestions. As presented hereinabove, Erikson only teaches and suggests a device for taking up the necessarily small gap produced by "nut wear," for which one revolution of spring loading would be extreme overkill.

Moreover, Erikson teaches against loading a spring more than necessary to accommodate nut wear, as such loading would only increase the "force between nut halves," without providing any added benefit. As appreciated, this is contrary to the expressed objective of Erikson to minimize such forces. (See Erikson column 1, lines 30-40 and column 3, lines 35-41.) Accordingly, any rejection of claims 21-24, 28-32, 34 and 35 based on a combination of Reh and Erikson is improper and should not be maintained.

With respect to the second independent basis, Reh and Erikson teach against one another, thereby destroying the requisite suggestion or motivation to combine reference teachings. For example, Reh teaches a take-up device that "must be able to resist contraction, even under the high stress loadings which occur during earthquakes." (Reh column 3, lines 35-37.) In contrast, Erikson teaches "fine" threads that must only withstand "very little force." (Erikson column 3, lines 32-40.)

The Office Action asserts that "the skilled artisan would have recognized to provide threads of adequate strength since it is known to make threads of appropriate size for their intended use." However, in making this assertion, the Office Action ignores other teachings of Erikson. Erikson teaches the use of "fine enough thread so as not to be contrarotated once advanced." (Erikson column 3, lines 32-34.) In specifically calling out threads fine enough to resist back rotation, Erikson teaches that coarse threads (which might support larger loads) would be incapable of resisting back rotation

when compressed. This teaching destroys the suggestion or motivation that one of ordinary skill in the art would have to apply threads to the devise of Reh. Reconsideration is respectfully requested.

**Rejection of Claims 25-27 and 33 Under 35 U.S.C. §103(a)**

Claims 25-27 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reh in view of Erikson and Simon

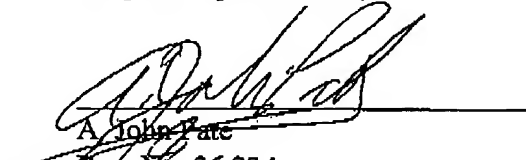
As stated hereinabove, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See MPEP 2143.)

The combination of Reh, Erikson, and Simon fails to meet this test for at least two independent bases. First, as presented hereinabove the combination of Reh and Erikson fails to teach or suggest all of Applicant's claim limitations. The addition of Simon cannot remedy this deficiency, as Simon does not teach or suggest a spring at all. Second, as presented hereinabove, Reh teaches against incorporation of the threads taught by Erikson, destroying the requisite suggestion or motivation to combine reference teachings. The addition of Simon does not remedy the incompatibility between Reh and Erikson. Reconsideration is respectfully requested.

In the event that the examiner finds any remaining impediment to the prompt allowance of any of these claims, which could be clarified in a telephone conference, the examiner is respectfully urged to initiate the same with the undersigned.

DATED this 19<sup>th</sup> day of December, 2005.

Respectfully submitted,

  
A. John Pate  
Reg. No. 36,234  
Attorney for Applicant

Date: December 19, 2005

PATE PIERCE & BAIRD  
550 Parkside Tower  
215 South State Street  
Salt Lake City, Utah 84111  
Telephone: (801) 530-0330  
Facsimile: (801) 530-5955

2863-2-i-3 PAT-FIL-ROA2 051212.vpd